

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN and MICHAEL L. GOUGH

Appeal No. 2005-1726
Application No. 08/810,679

ON BRIEF

MAILED

JAN 10 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before RUGGIERO, DIXON, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1 and 21-31, which are all the claims remaining in the application.

We affirm-in-part.

BACKGROUND

The invention relates to network (e.g., Internet) accessible computers implementing host computer programs that permit the computers to operate as host computers for client computers connected to the network, such that input devices of the client computers can be used to generate inputs to the host computers and image information generated by the host computers can be viewed by the client computers.

Claim 1 is reproduced below.

1. A network accessible computer comprising:
 - a central processing unit;
 - memory coupled to the central processing unit; and
 - an interface coupling said central processing unit to a TCP/IP protocol network;

wherein said central processing unit implements a host computer program stored in said memory which permits it to operate as a network-accessible host computer for a client computer coupled to said TCP/IP protocol network, wherein said client computer is operating a browser program having a browser window and a client program transmitted to said client computer via said network to operate in conjunction with said browser program to communicate with said host computer program, wherein input devices of said client computers can be used to generate inputs to said host computer as if the input devices were connected to said host computer, and such that image information generated by said host computer and sent in portions containing incremental changes can be viewed on a display of said client computer as if it was connected to said host computer.

The examiner relies on the following references:

Bartholomew et al. (Bartholomew)	4,939,509	Jul. 3, 1990
Frese, II et al. (Frese)	5,909,545	Jun. 1, 1999 (filed Jan. 19, 1996)

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Claims 1 and 21-31 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 and 21-31 of copending Application No. 08/798,704.

Claims 1 and 21-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bartholomew and Frese.

We refer to the Rejection (mailed Nov. 12, 2003) and the Examiner's Answer (mailed Jul. 12, 2004) for a statement of the examiner's position and to the Brief (filed Apr. 16, 2004) and the Reply Brief (filed Sep. 16, 2004) for appellants' position with respect to the claims which stand rejected.

OPINION

Double patenting

In support of the rejection of the claims that are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims in copending Application No. 08/798,704, the examiner compares portions of instant claim 25 with portions of “[c]laim 1 of 08/798,704.” (Answer at 3-4.) Applicants do not submit substantive arguments against the rejection in the Brief (but merely observe that the rejection “compares a process claim to an apparatus claim.”). Applicants “would agree” to the filing of a terminal disclaimer. (Brief at 4-5.)

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In the Reply Brief (at 2), however, appellants state that claim 1 of the "704 patent" [sic; Application No. 09/798,704] has "been long canceled." Appellants submit that there can thus be no double patenting issue.

According to USPTO computer database records, the Board entered a decision on appeal (Appeal No. 2003-0702) in Application No. 09/798,704 on June 28, 2004. In that decision, inter alia, the rejection of claim 1 was sustained over prior art. An examiner's amendment and a notice of allowability mailed on November 12, 2004, although the application has not yet issued as a patent.

The instant Answer mailed on July 12, 2004, during a period in which Application No. 09/798,704 was in the Board's jurisdiction after the affirmance of a rejection. We also note that the Board's decision in the '704 application was entered after the filing of the instant Brief, but before the filing of the instant Reply Brief. The examiner did not clarify the record in response to the Reply Brief.

The above-noted sequence of events recorded in the USPTO database is consistent with appellants' contention that claim 1 of the '704 application has been canceled. The provisional obviousness-type double patenting rejection could be dismissed as moot if the rejection were over claim 1 of the application alone. However, the rejection asserts that instant claims 1 and 21-31 are not patentably distinct from claims 1 and 21-31 of the application. Portions of one claim (instant claim 25) have been compared with portions of a claim in the '704 application (claim 1) that has been canceled.

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We conclude that a prima facie case for double patenting over claims in the '704 application has not been set forth. We note that our reversal of the rejection is based on the facts that are before us, and does not preclude the examiner's reassessment of the claims in the instant application in view of the claims that remain in the '704 application. However, on this record, we cannot sustain the provisional rejection of claims 1 and 21-31 under the judicially created doctrine of obviousness-type double patenting over claims in copending Application No. 08/798,704.

Prior art

Appellants submit a proposed grouping of claims, subject to the rejection over the prior art, at page 3 of the Brief. However, consistent with the rules effective at the filing of the Brief, we will consider the claims that are separately argued as the representative claims. See 37 CFR § 1.192(c)(7) (2003). See also In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.").

The examiner offers the combined teachings of Bartholomew and Frese to show prima facie obviousness of instant claim 1. (Answer at 4-5.) Appellants refer to the instant specification, which states that the present invention permits "virtually the entire

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functionality" of a computer system to be made accessible to a wide area network such as the Internet. (Brief at 5-6.) According to appellants, neither Bartholomew nor Frese can allow virtually the entire functionality of the host computer system to be taken over, but allow for the remote control of a specified application program. Appellants submit that, in fact, both Bartholomew and Frese "teach away" from allowing virtually the entire functionality of a host computer to be taken over by a client computer. (Id. at 6-8.) Appellants repeat the arguments in relation to claim 25. (Id. at 10-11.)

The examiner responds that the argument is not persuasive because the features upon which appellants rely are not recited in the rejected claims. (Answer at 8.) Appellants, in turn, allege deficiencies of Bartholomew taken alone, and reiterate the argument that the claims require control of the entire functionality of a remote computer. (Reply Brief at 2-4.)

We agree with the examiner. Instant claim 1 (or 25) does not specify or require the limitations argued by appellants. Appellants' arguments are not commensurate with the scope of the claims. The claims measure the invention. SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969).

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We add that it is not apparent how instant claim 1 or 25 might distinguish over Frese taken alone. Frese discloses, as summarized in column 9, a first computer initiating communication with a second computer over a TCP/IP protocol network, transporting the program component which supports remote control between the two computers, and allowing the first computer to remotely control an application program at the second computer. The system includes a browser (30) and a remote display module (18) at the first computer (16) (Fig. 1). In any event, a claim that is anticipated is also obvious under 35 U.S.C. § 103. Anticipation is the epitome of obviousness.

See, e.g., Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Instant claim 22 recites that the image information (transmitted from the host program to the client computer) "includes web page information." According to appellants, the claim "adds a limitation that is not even possible to achieve in either Bartholomew or Frese: the ability of a user at a client machine to use a host machine to access the Internet for browsing." (Brief at 9.)

We are in substantial agreement with the examiner's position set out at pages 9 and 10 of the Answer. Moreover, Frese allows a user (client) to run an application program on a host computer. A browser is a type of application program. Frese col. 7, II. 16-20. Even if the image information including "web page information" were to require the limitation argued by appellants, Frese discloses a system that the artisan

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would recognize as enabling a client machine to use a host machine to access the Internet for browsing.

With respect to claim 28, the rejection asserts that it would have been obvious for one of ordinary skill in the art to use encryption to improve security of the communication over the Internet. (Answer at 6.) The examiner adds that the use of encryption over the Internet was well known at the time of invention. According to the examiner, whether Bartholomew and Frese would want to encrypt their data is "not relevant." One would have been motivated to encrypt the data when needed to further secure the communication. (Id. at 10-11.)

We agree with the substance of appellants' arguments in the briefs. The evidence provided for the rejection of claim 28 is not sufficient to show prima facie obviousness of the subject matter as a whole. No reference is supplied to show encryption within the meaning of claim 28. Moreover, no reason is shown for transmitting encrypted information over the TCP/IP protocol network in the references that are applied. Frese teaches a security component that may parse attribute and parameter information, and additional security components such as use of a password, in the paragraph bridging columns 7 and 8 of the reference. However, the rejection does not rely on the noted section of Frese, and there is thus no explanation provided as to how that disclosure might have suggested use of encryption to the artisan. We

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cannot sustain the rejection of claim 28, nor of claims 29 and 30 which depend therefrom.¹

Appellants argue that the references do not disclose or suggest that client information transmitted to the host computer include "client interests, client resolution information, and client computer events," as recited in claim 31. We find the examiner's position to be reasonable (e.g., Answer at 6-7 and 12). While appellants stress the disclosure of Bartholomew (Brief at 14; Reply Brief at 8), the examiner relies on Frese for the relevant teachings. Sending information, as broadly recited, from the client system would have been necessary for effecting the remote control session taught by Frese. We further note that Frese provides examples of information concerning the client's display environment that is transmitted from the client (user system 16) to the host at column 7, lines 28 through 62, which would have suggested sending of additional information such as display resolution.

In view of the foregoing, we sustain the § 103 rejection of claims 1, 21 through 27, and 31. We do not sustain the § 103 rejection of claims 28 through 30.

¹ We note that "said computer's screen" in claim 28 lacks proper antecedent in the claims. The recitation should apparently be "said host computer's screen." The error appears to have been introduced in an amendment filed September 2, 2003, which did not accurately reproduce the previous version of the claim.

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CONCLUSION

The provisional rejection of claims 1 and 21-31 under the judicially created doctrine of obviousness-type double patenting over claims in copending Application No. 08/798,704 is reversed.

The rejection of claims 1 and 21-31 under 35 U.S.C. § 103 as being unpatentable over Bartholomew and Frese is affirmed with respect to claims 1, 21-27, and 31, but reversed with respect to claims 28-30.

The examiner's decision to reject claims 1 and 21-31 is thus affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge


JOSEPH L. CANNON

JOSEPH L. DIXON
Administrative Patent Judge

Howard B. Blankenship
HOWARD B. BLANKENSHIP
Administrative Patent Judge

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